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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,713	01/22/2002	Andrew Jamieson	8325-0026	6239

23419 7590 06/20/2003

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EXAMINER
COLLINS, CYNTHIA E

ART UNIT	PAPER NUMBER
1638	8

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/057,713	REAL, RICHMOND ANDREW	
	Examiner	Art Unit	
	Cynthia Collins	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4, drawn to a modified plant zinc finger protein that binds to a target DNA sequence of 3 or more contiguous nucleotides, classified in class 530, subclass 300, for example.

II. Claims 1, 5 and 6, drawn to a modified plant zinc finger protein comprising a tandem array of zinc fingers, wherein one or more of the zinc fingers are obtained by rational design, classified in class 530, subclass 377, for example.

III. Claims 1, 5, 7 and 8, drawn to a modified plant zinc finger protein comprising a tandem array of zinc fingers, wherein one or more of the zinc fingers are obtained by selection, classified in class 530, subclass 350, for example.

IV. Claims 1, 5 and 9, drawn to a modified plant zinc finger protein comprising a tandem array of zinc fingers, wherein one or more of the zinc fingers comprise canonical C_2H_2 zinc fingers, classified in class 530, subclass 324, for example.

V. Claims 1, 5 and 10, drawn to a modified plant zinc finger protein comprising a tandem array of zinc fingers, wherein one or more of the zinc fingers comprise non-canonical zinc fingers, classified in class 530, subclass 370, for example.

VI. Claims 1, 5 and 11, drawn to a modified plant zinc finger protein comprising a tandem array of zinc fingers, wherein one or more of the zinc fingers are derived from two or more plant species, classified in class 530, subclass 370, for example.

VII. Claims 1, 5, 12 and 13, drawn to a modified plant zinc finger protein comprising a tandem array of zinc fingers, wherein one or more amino acid residues are deleted or substituted as compared to a naturally occurring plant zinc finger protein, classified in class 435, subclass 440, for example.

VIII. Claims 14 and 15, drawn to a fusion polypeptide comprising a modified plant zinc finger domain and at least one functional domain that is a repressive domain, classified in class 435, subclass 69.7, for example.

IX. Claims 14 and 16, drawn to a fusion polypeptide comprising a modified plant zinc finger domain and at least one functional domain that is an activation domain, classified in class 530, subclass 370, for example.

X. Claims 17-19 drawn to an isolated polynucleotide, classified in class 536, subclass 23.6, for example.

XI. Claim 20, drawn to a method for modulating gene expression in a plant cell, classified in class 514, subclass 2, for example.

Claims 1, 5 and 14 will be examined to the extent that they read on the elected invention.

Applicants are reminded that different nucleic acid and amino acid sequences are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleic acid and amino acid sequence is presumed to represent an independent and distinct invention, subject to a restriction

requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq. This requirement is not to be construed as a requirement for an election of species, since each nucleic acid and amino acid sequence is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

Accordingly, If Group X is elected, Applicant is required to elect a single type of polynucleotide encoding a single type of zinc finger protein set forth in Groups I-VII.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different functions, and different effects. The polypeptides of inventions I-IX are structurally and functionally different from the polynucleotide of invention X, and they can be used in different methods, such as immunoassay methods for the polypeptides and hybridization methods for the polynucleotide. The polypeptides of inventions I-IX are also structurally or functionally different from each other. The modified plant zinc finger protein of invention I binds to a target DNA sequence of 3 or more contiguous nucleotides, which is not required of the polypeptides of inventions II-IX. The modified plant zinc finger protein of invention II comprises a tandem array of zinc fingers wherein one or more of the zinc fingers are obtained by rational design, which is not required of the polypeptides of inventions I and III-IX. The modified plant zinc finger protein of invention III comprises a tandem array of zinc fingers wherein one or more of the zinc fingers are obtained by selection, which is not required of the polypeptides of inventions I-II and IV-IX. The

modified plant zinc finger protein of invention IV comprises a tandem array of zinc fingers wherein one or more of the zinc fingers comprise canonical C_2H_2 zinc fingers, which is not required of the polypeptides of inventions I-III and V-IX. The modified plant zinc finger protein of invention V comprises a tandem array of zinc fingers wherein one or more of the zinc fingers comprise non-canonical zinc fingers, which is not required of the polypeptides of inventions I-IV and VI-IX. The modified plant zinc finger protein of invention VI comprises a tandem array of zinc fingers wherein one or more of the zinc fingers are derived from two or more plant species, which is not required of the polypeptides of inventions I-V and VII-IX. The modified plant zinc finger protein of invention VII comprises a tandem array of zinc fingers wherein one or more amino acid residues are deleted or substituted as compared to a naturally occurring plant zinc finger protein, which is not required of the polypeptides of inventions I-VI and VIII-IX. The fusion polypeptide of invention VIII comprises a modified plant zinc finger domain and at least one functional domain that is a repressive domain, which is not required of the polypeptides of inventions I-VII and IX. The fusion polypeptide of invention IX comprises a modified plant zinc finger domain and at least one functional domain that is an activator domain, which is not required of the polypeptides of inventions I-VIII.

Inventions XI and II-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of Groups II-VII can be used in a materially different process of using those products, such as in immunoassay or immunization methods.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Remarks

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC
June 13, 2003

DAVID T. FOX
PRIMARY EXAMINER
GROUP ~~180~~ 1638